

**§ 1.651 Setting times for discovery and taking testimony, parties entitled to take testimony.**

(a) At an appropriate stage in an interference, an administrative patent judge shall set a time for filing motions (§1.635) for additional discovery under §1.687(c) and testimony periods for taking any necessary testimony.

(b) Where appropriate, testimony periods will be set to permit a party to:

(1) Present its case-in-chief and/or case-in-rebuttal and/or

(2) Cross-examine an opponent's case-in-chief and/or a case-in-rebuttal.

(c) A party is not entitled to take testimony to present a case-in-chief unless:

(1) The administrative patent judge orders the taking of testimony under §1.639(c);

(2) The party alleges in its preliminary statement a date of invention prior to the effective filing date of the senior party;

(3) A testimony period has been set to permit an opponent to prove a date of invention prior to the effective filing date of the party and the party has filed a preliminary statement alleging a date of invention prior to that date; or

(4) A motion (§1.635) is filed showing good cause why a testimony period should be set.

(d) Testimony, including any testimony to be taken in a place outside the United States, shall be taken and completed during the testimony periods set under paragraph (a) of this section. A party seeking to extend the period for taking testimony must comply with §§1.635 and 1.645(a).

[56 FR 42529, Aug. 28, 1991; 56 FR 46823, Sept. 16, 1991, as amended at 60 FR 14528, Mar. 17, 1995]

**§ 1.652 Judgment for failure to take testimony or file record.**

If a junior party fails to timely take testimony authorized under §1.651, or file a record under §1.653(c), an administrative patent judge, with or without a motion (§1.635) by another party, may issue an order to show cause why judgment should not be entered against the junior party. When an order is issued under this section, the Board shall enter judgment in accordance

with the order unless, within 15 days after the date of the order, the junior party files a paper which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 15 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party.

[60 FR 14528, Mar. 17, 1995]

**§ 1.653 Record and exhibits.**

(a) Testimony shall consist of affidavits under §§1.672 (b), (c) and (g), 1.682(c), 1.683(b) and 1.688(b), transcripts of depositions under §§1.671(g) and 1.672(a) when a deposition is authorized by an administrative patent judge, transcripts of depositions under §§1.672(d), 1.682(d), 1.683(c) and 1.688(c), agreed statements under §1.672(h), transcripts of interrogatories, cross-interrogatories, and recorded answers and copies of written interrogatories and answers and written requests for admissions and answers under §1.688(a).

(b) An affidavit shall be filed as set forth in §1.677. A certified transcript of a deposition, including a deposition cross-examining an affiant, shall be filed as set forth in §§1.676, 1.677 and 1.678. An original agreed statement shall be filed as set forth in §1.672(h).

(c) In addition to the items specified in paragraph (b) of this section and within a time set by an administrative patent judge, each party shall file three copies and serve one copy of a record consisting of:

(1) An index of the names of the witnesses for the party, giving the pages of the record where the direct testimony and cross-examination of each witness begins.

(2) An index of exhibits briefly describing the nature of each exhibit and giving the page of the record where each exhibit is first identified and offered into evidence.

(3) The count or counts.

(4) Each affidavit by a witness for the party, transcript, including transcripts of cross-examination of any affiant who testified for the party and transcripts of compelled deposition testimony by a witness for the party, agreed statement relied upon by the

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party, and transcript of interrogatories, cross-interrogatories and recorded answers.

(5) [Reserved]

(6) Any evidence from another interference, proceeding, or action relied upon by the party under § 1.683.

(7) Each request for an admission and the admission and each written interrogatory and the answer upon which a party intends to rely under § 1.688.

(d) The pages of the record shall be consecutively numbered to the extent possible.

(e) The name of each witness shall appear at the top of each page of each affidavit or transcript.

(f) [Reserved]

(g) The record may be produced by standard typographical printing or by any other process capable of producing a clear black permanent image. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. Footnotes may not be printed in type smaller than 9 point. The page size shall be 21.8 by 27.9 cm. (8½ by 11 inches) (letter size) with printed matter 16.5 by 24.1 cm. (6½ by 9½ inches). The record shall be bound with covers at their left edges in such manner as to lie flat when open to any page and in one or more volumes of convenient size (approximately 100 pages per volume is suggested). When there is more than one volume, the numbers of the pages contained in each volume shall appear at the top of the cover for each volume.

(h) [Reserved]

(i) Each party shall file its exhibits with the record specified in paragraph (c) of this section. Exhibits include documents and things identified in affidavits or on the record during the taking of oral depositions as well as official records and publications filed by the party under § 1.682(a). One copy of each documentary exhibit shall be served. Documentary exhibits shall be filed in an envelope or folder and shall not be bound as part of the record. Physical exhibits, if not filed by an officer under § 1.676(d), shall be filed with the record. Each exhibit shall contain a label which identifies the party submitting the exhibit and an exhibit number, the style of the interference (e.g., Jones v. Smith), and the inter-

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ference number. Where possible, the label should appear at the bottom right-hand corner of each documentary exhibit. Upon termination of an interference, an administrative patent judge may return an exhibit to the party filing the exhibit. When any exhibit is returned, an order shall be entered indicating that the exhibit has been returned.

(j) Any testimony, record, or exhibit which does not comply with this section may be returned under § 1.618(a).

[49 FR 48455, Dec. 12, 1984; 50 FR 23124, May 31, 1985, as amended at 60 FR 14528, Mar. 17, 1995]

### § 1.654 Final hearing.

(a) At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing. An administrative patent judge may set a date and time for final hearing. Unless otherwise ordered by an administrative patent judge or the Board, each party will be entitled to no more than 30 minutes of oral argument at final hearing. A party who does not file a brief for final hearing (§ 1.656(a)) shall not be entitled to appear at final hearing.

(b) The opening argument of a junior party shall include a fair statement of the junior party's case and the junior party's position with respect to the case presented on behalf of any other party. A junior party may reserve a portion of its time for rebuttal.

(c) A party shall not be entitled to argue that an opponent abandoned, suppressed, or concealed an actual reduction to practice unless a notice under § 1.632 was timely filed.

(d) After final hearing, the interference shall be taken under advisement by the Board. No further paper shall be filed except under § 1.658(b) or as authorized by an administrative patent judge or the Board. No additional oral argument shall be had unless ordered by the Board.

[49 FR 48455, Dec. 12, 1984, as amended at 60 FR 14529, Mar. 17, 1995]

### § 1.655 Matters considered in rendering a final decision.

(a) In rendering a final decision, the Board may consider any properly